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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

POND, ROBERT M

ART UNIT PAPER NUMBER

3625

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 09/779,974	<b>Applicant(s)</b> BRICE ET AL.	
	<b>Examiner</b> Robert M. Pond	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>17 May 2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

The Applicant amended Claim 1, newly added Claims 14-18, and based arguments over the prior reference based on the amended claims. All pending claims (1-18) were examined in the final Office Action necessitated by amendment.

### ***Response to Arguments***

#### **Objection to Drawings**

The Applicant amended Figure 1 and the specification. Objections are withdrawn.

#### **Objection to Specification**

The Applicant amended Figure 2 and the specification. Objections are withdrawn.

#### **Rejection under 35 USC 101**

Rejection of Claims 7-13 under 35 USC 101 is withdrawn. The Examiner ascertained the Applicant's definition of "dynamically" sufficiently conveys the use of a computer to package bundled items.

Applicant's arguments filed 12 May 2004 regarding rejection of Claims 1-6 under 35 USC 101 have been fully considered but they are not persuasive. The Applicant argues Claims 1-6 meet statutory subject matter requirements. The

Examiner maintains the position that mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. There is no practical application in the technological arts as presently claimed. For instance, in Bowman the board affirmed the rejection under U.S.C. 101 as being directed to non-statutory subject matter. The Board held that the disclosed and claimed invention is directed merely to a human making mental computations and manually plotting results on a paper chart, and thus is nothing more than an abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution (Ex parte Bowman, 61 USPQ2d 1665, 1671). Even though Bowman is not precedential, Bowman is referenced for its analysis of whether the claims are in the technological arts. Regardless, practical application of the technological arts is lacking in each independent claim and dependent claims.

Rejection under 35 USC 102(e)

Applicant's arguments filed 12 May 2004 have been fully considered but they are not persuasive. The Applicant amended Claim 1 and newly added Claims 14-18, and based arguments on amended and newly added claims. Rejection under 102(e) was withdrawn in favor of rejection under 103(a) in order to respond to the Applicant's amended Claim 1 and newly added claims. Domenick and Andrews (Paper #8) was cited to address dynamic bundle package creation based on consumer request and compensation.

Rejection under 35 USC 103(a)

Applicant's arguments filed 12 May 2004 have been fully considered but they are not persuasive.

The Applicant argues that it is not well known to determine the compensation due at least one selling agent based upon a package of items that has been generated in response to a request from a potential purchaser. The Applicant's amended Claim 1 was amended to a) identify bundled packaging vendors based on the customer's request versus the system pushing a pre-packaged bundle to the consumer, and b) determining compensation based on the requested bundled package. Newly cited Domenick teaches the customer requesting bundled products. The Applicant is determining what the compensation will be when the purchase is completed. As cited below, Domenick and Andrews (Paper #8) provide these teachings.

The Applicant admits to the Examiner's Official Notice regarding commission structures as being well-known and therefore Official Notice (Paper #8, regarding commission structures for selling agents) is admitted as prior art.

The Applicant's request for documentary proof as noted on Applicant's Remarks, page 14 is provided by the teachings of Domenick and Andrews (Paper #8).

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

- 1. Claims 1-6 are rejected under 35 USC 101 because the claimed invention is directed to non-statutory subject matter.**

The claims are directed to a process that does nothing more than manipulate an abstract idea. Mere recitation in the preamble (i.e., intended use) or mere implication of employing a machine or article of manufacture to perform some or all of the recited steps does not confer statutory subject matter to an otherwise abstract idea. There is no practical application in the technological arts. For subject matter to be statutory, the claimed process must be limited to a practical application of the abstract idea or mathematical algorithm in the technological arts. See *In re Alappat* 33 F.3d at 1543, 31 USPQ2d at 1556-57 (quoting *Diamond V. Diehr*, 450 U.S. at 192, 209 USPQ at 10). A claim is limited to a practical application when the method, as claimed, produces a concrete, tangible and useful result: i.e. the method recites a step or act of producing something that is concrete, tangible and useful. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-4, 6-10, and 14-18 are rejected under 35 USC 103(a) as being unpatentable over Domenick et al. (patent application number 2002/0072937 hereinafter referred to as "Domenick"), in view of Andrews (Paper #8, patent number 6,285,986).**

Domenick teaches a system and method for presenting travel packages on-demand in response to a particular customer request. Domenick further teaches:

- Receiving a request identifying an interest in a set of items: packaging-on-demand involving the creation of a travel package in response to a particular customer request (see at least page 2, 0022); communicating with customers (see at least page 3, 0026; page 4, 0037).
- Identifying potential providers capable of providing items; in response to receiving the request: communicating with potential providers (see at least pages 2-3, 0025; page 3, 0028; page 4, 0036).
- Packaging multiple items from a plurality of different providers: vacation package including car rental; different providers (see at least page 3, 0028; page 4, 0037).

- Providing information reflecting the package of items: communicating offers with customer over email or web site (see at least page 3, 0029).
- Receiving a purchase request: packaging system receives customer order (see at least page 4, 0036).
- Providing a confirmation: dynamic packaging engine receives the customer order, confirms availability, and books the services on behalf of the customer (see at least page 3, 0029).
- Discounting packaged items: rental car company offering a discount for its services when packaged in combination with airfare from a particular airline (see at least page 4, 0034). Please note examiner's interpretation: price of car rental will be less than if purchased alone, and total price of package combining car rental with a particular airline results in cost that is less than the sum of the car rental purchased alone and airfare purchased alone.
- Package request processor: dynamic packaging engine (see at least Fig. 2 (204); page 3, 0029).
- Provider database: market place engine and provider database (see at least Fig. 2 (202, 208); page 3, 0028).
- System generates packages based partially on agreements: rules determining provider's items are validly included (see at least page 3, 0028; 0034).



- Booking engine: dynamic packaging engine reserves requested services on behalf of the consumer (see at least page 3, 0029).
- Determining compensation to at least one selling agent:

Domenick teaches all the above as noted under the 103(a) rejection and teaches a) selling agents, b) a bundled packaging system connecting consumers to sellers (please note examiner's interpretation: automated system is a selling agent for the sellers), c) sellers supplying products and services for a bundled offering, and b) purchases being made by buyers, but does not disclose determining compensation to at least one selling agent. Andrews teaches a system and method of bundling products and services from one or more providers at a bundle server (please note examiner's interpretation: a selling agent for the bundled vendors) in communication over a network with vendors of products and services, the bundle server providing information on the bundled package of items (e.g. bundle profile), and receiving a request to purchase a bundle package from a participating member (please see at least abstract; Fig. 1 (10, 24, 26-32, 34-40); col. 2, line 59 through col. 4, line 44). Andrews teaches a bundle vendor taking the responsibility of generating a bundle package (please note examiner's interpretation: bundle vendor becomes selling agent for other vendors included in the bundle; an appropriate party). Andrews teaches the controller's bundled tracking system tracking and generating status conditions, and further teaches a bundled package

status whereby a closed status indicates that the bundle has been completely sold and all appropriate parties have been paid (please note examiner's interpretation: system and method determines compensation for all appropriate parties). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method Domenick to process compensation for all appropriate parties as taught by Andrews, in order to attract selling agents and vendors to participate in the service.

Domenick and Andrews teach all the above as noted under the 103(a) rejection and teach a) travel agents as selling agents for providers, b) a bundle vendor as a selling agent for vendors included in a bundled package, c) selling agents selling bundled products for vendors selling products, and d) determining that all appropriate parties have been compensated once a bundle package sell is complete, but do not specifically disclose compensating at least one selling agent. It would have been obvious to one of ordinary skill in the art at time of the invention to disclose determining compensation for selling agents, since it is well within the skill to ascertain that selling agents are an appropriate party to receive compensation.

*Pertaining to system Claims 14-17*

Rejection of Claims 14-17 is based on the same rationale as noted above.

- 3. Claim 5 is rejected under 35 USC 103(a) as being unpatentable over Domenick (patent application number 2002/0072937) and Andrews (Paper #8, patent number 6,285,986), in view Official Notice (Paper #8, regarding commission structure).**

Domenick and Andrews teach all the above as noted under the 103(a) rejection and further teach selling agents using the system to sell bundle packages (see at least col. 13, lines 16-22) and all parties involved in selling a bundle package being compensated, but does not specifically disclose a commission structure. This examiner takes the position that it is old and well-known that sellers of goods and services are compensated by being paid a commission based upon old and well-known commission structures (e.g. a percentage of gross sales, a percentage of net sales (sales price minus costs), or combination). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Andrews to disclose a commission structure as taught by Official Notice, in order to more fully inform selling agents and providers how they will be compensated, and thereby attract providers to the bundled package service.

- 4. Claims 11-13 are rejected under 35 USC 103(a) as being unpatentable over Domenick (patent application number 2002/0072937) and Andrews (Paper #8, patent number 6,285,986), as applied to Claim 1, further in view**

**of Walker et al. (Paper #5, IDS, patent number 6,138,105 hereinafter referred to as "Walker").**

Domenick and Andrews teach all the above as noted under the 103(a) rejection and further teach a) the bundle server prompting the vendor for item suggested retail price and the item price if included in a bundled package, and b) minimum auction price if included in an auctioned bundle (see at least col. 8, lines 13-21), but do not disclose specifics on bundle pricing schemes. Walker teaches bundled packaging of goods and services and pricing of bundled packages. Walker further teaches:

- bundling French fries (X: examiner's notation for regular retail price of French fries) and soda (Y: examiner's notation for regular retail price of soda) at a single price that is less than the sum of the prices of the individual products (bundled single price < (X+Y)) (see col. 1, lines 33-37),
- bundling of product X (product ID 1) with product Y (product ID 2) where at least the bundled price of X is 10% less than retail price of X by a predetermined percentage (see at least Fig. 5 (506); col. 6, lines 35-62).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Domenick and Andrews to disclose bundled pricing methods as taught by Walker, in order to provide a pricing incentive to the consumer, and thereby increase sales.

Domenick and Andrews teach all the above as noted under the 103(a) rejection and further teach a) each vendor providing a suggested retail price, and

b) establishing an item price if included in a bundled package, but do not specifically disclose the item being less than the item suggested retail price by a percentage. Walker teaches all the above as noted under the 103(a) rejection and teach setting an item price included in a bundle lower than the retail price of the item by a predetermined percentage to create a purchasing incentive (see at least Fig. 5 (506); col. 6, lines 35-62). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the method of Domenick and Andrews to use a predetermined percentage to compute a lower item price as taught by Walker, in order to provide a pricing incentive to the consumer, and thereby increase sales.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Art Unit: 3625

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:


***Commissioner of Patents and Trademarks***

***Washington D.C. 20231***

or faxed to:

703-872-9306 (Official communications; including After Final  
communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal  
Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.



Robert M. Pond  
Patent Examiner  
September 7, 2004